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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,091	05/15/2001	Andrew C. Gilbert	CF/028	2562
1473	7590	04/10/2006	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			CAMPEN, KELLY SCAGGS	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/858,091	Applicant(s) GILBERT, ANDREW C.	
	Examiner Kelly Campen 	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
 4a) Of the above claim(s) 57 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>12/13/2005</u> . |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/17/06</u> . | 6) <input type="checkbox"/> Other: _____. |

Art Unit: 3624

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/17/06 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 3624

Claims 1-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginsberg (US 6,754,639) as cited in the prior office action.

Specifically as to claims 1, 15, 29, 43 a method for shifting bids or offers in trading system, comprising: receiving a selection of a plurality of bids or offers in a trading system; fig 6

Ginsberg discloses substantially simultaneously shifting of the selection of the plurality of bids or offers (abstract; fig 1430); fig 2 (330); fig 5 (850); col 4, L 5-10.

However, Ginsberg does not explicitly disclose price shifting for each of the plurality of bids or offers in the selection by a percentage of the prices of each respective bid or offer of the selection.

Official notice is taken that this feature is old and well known in the art.

By shifting terms (col 5, L 43-49) such as maturity by laddering, the price of the bonds shift such that the basket of securities shift (col 4, L 5-10). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement this feature for the advantage of adjusting data for changing market conditions.

Specifically as to claims 2, 16, 30, 44, further comprising allowing the user to input a percentage to shift prices for each of the plurality of bids or offers in the selection (col 4, L 6-10).

Specifically as to claims 3, 17, 31, 45, wherein the percentage shift in price is the same for each of the plurality of bids or offers in the selection (col 5, L 43-49).

Specifically as to claims 4, 18, 32, 46, wherein the shifting of the prices is performed in response to a request by a user. (col 5, L 2-10).

Specifically as to claims 5, 19, 33, 47 wherein the shifting of the prices is performed automatically. (col 5, L 2-10).

Art Unit: 3624

Specifically as to claims 6, 20,34,48 further comprising receiving from a user a status assignment for at least one of the plurality of bids or offers (col 5, L2-10).

Specifically as to claims 7,21,35,49, wherein the status assignment of the at least one of the plurality of bids or offers is an active status.(col 2, L14-22).

Specifically as to claims 8,22,36,50 wherein the active status permits hits or takes to be performed on the at least one of the plurality of bids or offers (col 2, L 14-22., col 9, L 34).

Specifically as to claims 9,23,37,51 Ginsberg does not explicitly disclose suspension wherein the status of the at least one of the plurality bids or offers a status. Official notice is taken that this feature of suspension is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement this feature for the advantage of keeping securities from trading under illegal conditions and any SEC requirements.

Specifically as to claims 10,24,38,52 wherein the suspended status blocks hits or takes from being on the at least one the plurality of bids or offers. (col 10, L27-40:blocks if price increases).

Specifically as to claims 11,25,39,53 Ginsberg does not explicitly disclose further canceling at least one of the plurality of comprising bids or offers. Official notice is taken that this feature is old and well known in the ad. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement this feature for the advantage of keeping securities from trading under illegal conditions and any SEC requirements.

Specifically as to claims 12,26,40,54 Ginsberg does not explicitly disclose comprising receiving a default parameter from that includes a default status parameter for the plurality of bids or offers. Official notice is taken that this feature is old and well known in the ad. It would have

Art Unit: 3624

been obvious to one of ordinary skill in the art at the time of applicant's invention to implement this feature for the advantage of sustaining trading for market continuity when data is limited. Specifically as to claims 13,27,41,55 Ginsberg does not explicitly disclose further comprising receiving a default parameter from a user that includes a default shift parameter for the plurality of bids or offers. Official notice is taken that this feature is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement this feature for the advantage of adjusting data for changing market conditions. Specifically as to claims 14,28,42,56 Ginsberg does not explicitly disclose further comprising receiving a default parameter from a user that is used to shift the prices of the plurality of bids or offers. Official notice is taken that this feature is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement this feature for the advantage of adjusting data for changing market conditions.

Response to Arguments

Applicant's arguments, see pages 14-15, filed 01/17/06, with respect to claims 1-56 have been fully considered and are persuasive. The 35 USC 101 rejection (lack of technology) of 8/25/05 has been withdrawn.

Regarding the arguments against official notice, applicant's traversal from 3/8/05 is not adequate; therefore, the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include

Art Unit: 3624

stating why the noticed fact is not considered to be common knowledge or well-known in the art.ⁱ A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate.

With regards to applicant's arguments concerning the 35 USC 103(a) rejection as being unpatentable over Ginsberg, Examiner disagrees and refers back to the above rejection of said claims. Based on the amendments made 1/17/06, applicant has not clearly defined over the Ginsberg reference as was indicated in the interview of December 13, 2005. At that time, applicant indicated that relative shift language would be added to include knowledge of how the market really is.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Campen whose telephone number is (571) 272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kelly S. Campen

ⁱ See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 (“[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.”).